

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

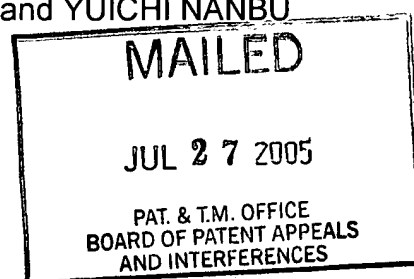
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte SHOICHI SAWA, TAKASHI FURUSAWA and YUICHI NANBU

Appeal No. 2005-1327
Application No. 10/064,064

ON BRIEF



Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 41.50(a)(1) for further consideration of a rejection and for appropriate action with regard to the items listed below.

In the present appeal, claims 1 through 5 and 10 through 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown (U.S. Patent No. 5,568,663) in view of White (U.S. Patent No. 2,421,228). Recognizing that the threaded connection between

the bottle (34) and the air intake valve or receiving member (24) of the inflatable mattress (12) seen in Figure 6 of Brown is clearly different than the particular form of connection set forth in the claims on appeal, it is the examiner's view that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention "to use the coupling as taught by White with the device of Brown in order to increase the speed in which the inflator may be attached" (answer, page 3). The examiner then goes on to contend that

Brown as modified further discloses the receiving member including grooves into which projections from the bottle mate in an axial direction, wherein the projection is configured to move axially within the receiving member prior to mating with the groove; wherein the bottle extends into the receiving member; wherein the projection is located on the outside of the bottle and extends in a direction generally perpendicular to the axial direction of the bottle; wherein an end of the bottle having the projection fits into an open end of the receiving member, wherein the receiving member is configured to communicate with an airbag (12). Brown as modified further discloses a bayonet-type connector that is known to have a guide groove, a key groove and a key that rests in the key groove to prevent releasing of the connection.

On pages 3-6 of the brief, appellants have pointed out features in each of independent claims 1, 2, 4, 10, 11, 17 and 20 that are said not to be disclosed, taught or suggested in the examiner's proposed combination of Brown and White. Although the examiner's answer is responsive to some of those arguments, we are at a loss to understand exactly what structure in the applied prior art the examiner considers to correspond to the various "grooves" set forth in the claims on appeal or to the "key" set forth in dependent claim 5 and independent claims 11 and 17. The examiner's cryptic

assertion on page 4 of the answer that “Brown as modified further discloses a bayonet-type connector that is known to have a guide groove, a key groove and a key that rests in the key groove to prevent releasing of the connection,” is of no help, since the examiner does not point to any structure in the applied references that is believed to correspond to the claimed structure. Thus, we remand for further clarification and an explanation from the examiner, with reference to specific elements in the applied prior art, as to where the various limitations noted above are to be found in the applied patents.

In the paragraph spanning pages 4 and 5 of the answer the examiner has urged that the bayonet slots (6) of White meet “the general definition of a ‘groove’” and then concludes that White therefore teaches the limitations of the claimed invention. Our problem is that the examiner has cited to no definition of “groove,” general or otherwise, to support this assertion. Thus, we remand for the examiner to provide evidence in support of the position taken in the answer and for a clear explanation of why the ordinary and customary meaning attributed by one of ordinary skill in the art to the term “groove” would have been such as to encompass the slots (6) of White which extend entirely through the wall of the cylindrical coupling member (5).

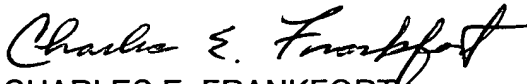
On January 27, 2005, appellants filed a reply brief. The reply brief includes 4 pages of argument and comments concerning the examiner’s position as set forth in the

answer and again urges that specific limitations in each of independent claims 1, 2, 4, 10, 11, 17 and 20 are not disclosed, taught or suggested in the examiner's proposed combination of Brown and White. In response to the reply brief, the examiner sent out a notice (mailed February 9, 2005) informing appellants that the reply brief had been "entered and considered" and that the application was being forwarded to the Board of Patent Appeals and Interferences for decision of the appeal. Our problem is that the examiner has not provided us with her views concerning the various arguments presented by appellants in the reply brief. Thus, we REMAND this application to the examiner for a response on the record to the arguments raised by appellants in the reply brief.


If a supplemental examiner's answer clarifying the issues discussed above is written in response to this remand, it follows that appellants may exercise one of the options set forth in 37 CFR § 41.50(a)(2).

This application, by virtue of its "special" status, requires immediate action, see
MPEP § 708.01 (item D), Eighth Edition, Rev. 2, May 2004.

REMAND TO THE EXAMINER



CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge
JEFFREY V. NASE
Administrative Patent Judge

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